

REMARKS

This paper is submitted in reply to the Office Action dated July 18, 2003, within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, claim 7 was rejected under 35 U.S.C. § 112 second paragraph. Moreover, claim 19 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,020,884 to MacNaughton et al. In addition, claims 1-2, 5-8, 13-18, 20-22, and 25-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of U.S. Patent No. 6,240,443 to Suzuki et al.; claims 3-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of Suzuki et al., in further view of "Chat Comp: Lobby," Yahoo!, <http://chat.yahoo.com>, downloaded 11/18/98, (hereinafter Yahoo); and claims 9 and 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of U.S. Patent No. 6,333,787 to Konno.

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained. Applicants have amended claim 7 herein, and Applicants respectfully submit that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed.

The Examiner's rejections will now be addressed in the order in which they appear in the Office Action.

Section 112 Rejections

First turning to the § 112, second paragraph rejection of claim 7, the Examiner rejects this claim by asserting that the limitation of "notifying the first user of the location of another hypertext document currently being viewed by a third user," is not disclosed in the specification.

Page 11 of 18
Serial No. 09/247,502
Amendment and Response
Reply to Office Action of July 18, 2003
IBM Docket RO998190
WH&E IBM/72
K:\ibm\72\Response to 7-18-03 OA.wpd

Applicants respectfully direct the Examiner's attention to Figs. 5A and 6, and the accompanying description at p. 19, lines 16-20 and p. 20, lines 18-19, which disclose the process whereby a current page for another user is returned in response to a request. While the word "location" is not explicitly discussed in these passages, the pages described in the embodiments are identified via Uniform Resource Locators (URL's), which are well known in the art as defining the "locations" of pages accessible via the World Wide Web. Applicants therefore respectfully submit that one of ordinary skill in the art would readily comprehend what is meant by the passage objected-to by the Examiner. Accordingly, reconsideration and withdrawal of the §112 rejection are respectfully requested.

Section 102(e) Rejections

Next, turning to the §102 rejections, and specifically to the rejection of independent claim 19, as discussed in Applicants' previous response, this claim recites, *inter alia* the concept of displaying a list of favorite links to a first user, where the list of favorite links is built by combining lists of favorite links associated with only those users currently viewing the same hypertext document as the first user.

Put another way, claim 19 recites a configuration where one user viewing a particular hypertext document is able to view the favorite links of other users that are currently viewing the same document, but not the favorite links of any users that are currently viewing other documents.

In rejecting this claim, the Examiner relies on col. 3, line 24 to col. 5, line 15 of MacNaughton et al. This passage discloses the concept of a "community bookmark," which is described at col. 4, lines 48-56 as being a bookmark for a web page contributed by a community member for the benefit of other members. Of note, however, claim 19 does not attempt to claim the concept of a shared bookmark or favorite link in the

abstract. Instead, claim 19 focuses on building a composite list of favorite links from the favorite link lists of those users that are viewing the same hypertext document.

MacNaughton et al. does not disclose or suggest any mechanism for building a list of favorite links from lists associated with other users that are viewing the same document. Indeed, the cited passage does not even appear to disclose building a favorite link list from other favorite link lists. MacNaughton et al. instead appears to disclose the generation of a community bookmark list that is based on the submission of individual bookmarks by community members. (See col. 4, lines 48-56).

Furthermore, even if the community bookmarks of MacNaughton et al. were read broadly enough to somehow suggest the construction of a list of favorite links from other favorite link lists, MacNaughton et al. could not be read to disclose or suggest basing the construction of such a list upon what documents different users were currently viewing. MacNaughton et al. simply does not base its list of "community bookmarks" on the locations of community members. Member locations are irrelevant to MacNaughton's community bookmarks, and as such, the reference is insufficient to anticipate claim 19.

Furthermore, the Examiner has provided no evidence of a motivation in the art to modify MacNaughton et al. to incorporate the functionality recited in claim 19, and as such, claim 19 is also non-obvious over the prior art of record. Reconsideration and allowance of claim 19 are therefore respectfully requested.

Section 103(a) Rejections

Next, turning to the §103 rejections, and specifically to the rejection of independent claim 1, this claim was previously amended to additionally recite the concept of a saved user list that identifies users that are accessing the same hypertext document, and that may be updated in response to user input to add and remove users to and from the list.

As noted in Applicants' previous response, the saved user list recited in claim 1 is maintained on behalf of a particular user, and is capable of being managed by that user.

In rejecting claim 1, the Examiner admits that the concept of a saved user list is not disclosed in MacNaughton et al. However, the Examiner now relies on Suzuki et al. for allegedly teaching maintaining a saved user list for a user with support for adding and removing users to and from the list in response to user input, citing a passage at col. 56, lines 46-61.

Initially, it should be noted that the cited passage appears to be incorrect, as there is no col. 56 in the reference. Nonetheless, Applicants have reviewed Suzuki et al., and can find no relevant teaching the reference directed to the concept of a saved user list with support for the addition and removal of users to and from the list in response to user input.

Instead, Suzuki et al. appears to disclose a centrally-managed user list for each document or URL being monitored by a communication server. As described, for example, in cols. 8-10, Suzuki et al. groups users based upon the current URL's being viewed by those users, and generates lists of users for each URL.

Of note, however, there is no disclosure or suggestion in Suzuki et al. of any functionality that permits an individual user to add or remove a user from a list, not to mention any functionality analogous to a personalized list for a user. Possibly the only disclosure even arguably relevant is found at col. 7, lines 35-42, which describes the ability of a user to select certain users from a user list with which to initiate a chat session. Nonetheless, the selection of users from a list (which it should be noted, is common to all of the users on the list), falls far short of adding or removing users from a saved user list, as is the subject of claim 1.

Claim 1, in particular, provides the ability for a user to maintain a personalized user list that is user-editable. As such, a user is able to select which users he or she will be notified about as viewing the same document. Such an implementation provides

significant benefits over the centrally-managed lists of Suzuki et al., particularly where hundreds or thousands of users are being tracked. Consider where a particular user is viewing the same document as 100 other users, of which only two or three were of interest to the user. With the Suzuki et al. system, the user would be notified of all 100 other users. In contrast, with the invention recited in claim 1, that user would be able to limit his or her saved user list to only those other users the user cared to be notified about.

Providing the ability to add or remove a user to or from a saved user list, as recited in claim 1, provides a unique and unexpected advantage that is not suggested by either MacNaughton et al. or Suzuki et al. Claim 1 is therefore non-obvious over this combination of references. Reconsideration and allowance of claim 1, and of claims 2-6, 13-18 and 20-22 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claim 7, this claim has now been amended to clarify that the second and third users are in a saved user list for the first user. The claim has also been amended to additionally recite the step of managing the saved user list for the first user in response to user input from the first user, including at least one of adding and removing users to and from the saved user list. As noted above in connection with claim 1, the recitation of a user-editable or manageable saved user list, in combination with the other features of claim 7, is not disclosed or suggested by the combination of MacNaughton et al. and Suzuki et al. Accordingly, Applicants respectfully submit that claim 7 is patentable over the prior art of record. Reconsideration and allowance of claim 7, and of claim 8 which depends therefrom, are therefore respectfully requested.

Next, with respect to independent claim 9, this claim generally recites a method of providing access to hypertext documents in a multi-user computer environment, which includes *inter alia* maintaining a navigation history for a second user, where the navigation history includes a set of hypertext documents previously accessed by the second user. The claim also recites the step of notifying the first user of the set of hypertext documents in the navigation history for the second user.

Page 15 of 18
Serial No. 09/247,502
Amendment and Response
Reply to Office Action of July 18, 2003
IBM Docket RO998190
WH&E IBM/72
K:\bm\72\Response to 7-18-03 OA.wpd

In rejecting claim 9, the Examiner admits that MacNaughton et al. does not disclose either maintaining a navigation history for a user, or notifying one user of the documents in the navigation history for another user. Instead, the Examiner relies on Konno to supply the missing disclosure, citing col. 4, lines 44-64.

Konno, however, discloses only a facsimile system that transmits web pages via facsimile, and provides the ability for a recipient to select hypertext links in transmitted web pages using coordinates displayed on the transmitted web pages. In addition, the specific passage cited by the Examiner discloses service menu management tables 111c that are provided on a user-by-user basis, and that store browsing history information for each user.

What Konno does not disclose, however, is any functionality for sharing navigation history information between users. Indeed, each table 111c is maintained for a particular user, and there is no disclosure or suggestion in the reference of any functionality for sharing the contents of such tables between users.

Furthermore, given the application of the Konno system in generating facsimile copies of web pages, Applicants submit that one of ordinary skill in the art would not look to Konno to disclose or suggest the sharing of navigation histories between users in a multi-user computer environment. Accordingly, Applicants submit that claim 9 is non-obvious over the combination of MacNaughton et al. and Konno. Reconsideration and allowance of claim 9 are therefore respectfully requested.

Next, with respect to independent claim 11, this claim generally recites a method of providing access to hypertext documents in a multi-user computer environment, which includes *inter alia* maintaining a navigation history for a second user, where the navigation history includes a set of hypertext documents previously accessed by the second user. The claim also recites the step of displaying a first hypertext document to the first user, where the first hypertext document includes a hypertext link to a second hypertext document that is in the navigation history for the second user, and where

Page 16 of 18
Serial No. 09/247,502
Amendment and Response
Reply to Office Action of July 18, 2003
IBM Docket RO998190
WH&E IBM/72
K:\ibm72\Response to 7-18-03 OA.wpd

displaying the first hypertext document includes displaying within the first hypertext document and in association with the hypertext link an indication that the second hypertext document is in the navigation history for the second user.

As with claim 9, the Examiner rejects claim 11 on the basis of MacNaughton et al. and Konno. The Examiner admits that MacNaughton et al. does not disclose either maintaining a navigation history for a user, or displaying a hypertext document in such a manner as to indicate that a link therein is to a document in the navigation history for another user. Again, the Examiner relies on Konno to supply the missing disclosure, citing col. 4, lines 44-64.

As noted above in connection with claim 9, however, Konno does not disclose any functionality for sharing navigation history information between users. Indeed, each table 111c is maintained for a particular user, and there is no disclosure or suggestion in the reference of any functionality for sharing the contents of such tables between users.

Furthermore, given the application of the Konno system in generating facsimile copies of web pages, Applicants submit that one of ordinary skill in the art would not look to Konno to disclose or suggest the sharing of navigation histories between users in a multi-user computer environment. Accordingly, Applicants submit that, as with claim 9, claim 11 is non-obvious over the combination of MacNaughton et al. and Konno. Reconsideration and allowance of claim 11, and of claim 12 which depends therefrom, are therefore respectfully requested.

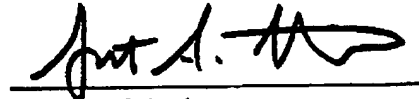
Finally, with respect to independent claim 25, this claim was previously amended to recite the concept of a user-maintained saved user list of users that are accessing the same hypertext document. As such, claim 25 is patentable over the prior art of record for the same reasons as presented above for claim 1. Reconsideration and allowance of claim 25, and of claims 26-36 which depend therefrom, are therefore respectfully requested.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending

claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

14 OCT 2003
Date

Respectfully submitted,



Scott A. Stinebruner
Reg. No. 38,323
WOOD, HERRON & EVANS, L.L.P.
2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202
Telephone: (513) 241-2324
Facsimile: (513) 241-6234

**RECEIVED
CENTRAL FAX CENTER**

OCT 15 2003

OFFICIAL

Page 18 of 18
Serial No. 09/247,502
Amendment and Response
Reply to Office Action of July 18, 2003
IBM Docket RO998190
WH&E IBM/72
K:\ibm\72\Response to 7-18-03 OA.wpd